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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/515,118	02/24/2000	Reuven Wachtfogel	NDS-4000 USA	7680

7590 06/30/2004  
Welsh & Katz, Ltd.  
120 South Riverside Plaza  
22nd Floor  
Chicago,, IL 60606

EXAMINER
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TRAN, HAI V

ART UNIT	PAPER NUMBER
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2611

21

DATE MAILED: 06/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/515,118

Applicant(s)

WACHTFOGEL ET AL.

Examiner

Hai Tran

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-93 is/are pending in the application.
- 4a) Of the above claim(s) 1-34 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 35-93 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____.  |

**DETAILED ACTION**

***Election/Restrictions***

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 35-53, drawn to a system to encode tags/decode tags to/from program material being broadcasted/received, classified in class 725, subclass 31.
- II. Claims 54-69, 77 drawn to Recording with Quality Level, classified in class 386, subclass 46.
- III. Claims 70-76, drawn to Commercial based on User profile/history, classified in class 725, subclass 34.
- IV. Claims 78-83 and 90 drawn to Recording/Playback base on user rating, classified in class 386, subclass 83.
- V. Claims 84-89, drawn to Broadcasts/receives browsable program structure in VOD environment, classified in class 725, subclass 88.
- VI. Claim 91-93, drawn to Operation of a receiver with a particular storage and control access for recording/playback function, classified in class 386, subclass 68.

Inventions II, III, IV, V, VI, and I are related as combination and subcombination.

Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other

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combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because

1. The detail of the broadest sub-combination claim 54, such as "...and recording said program material at selectable quality level" of Group II is not recited in the broadest combination claim 35 of Group I, claim 70 of Group III, claims 78 and 90 of Group IV, claims 84 and 88 of Group V, and claim 91 of Group VI.
2. The detail of the broadest sub-combination claim 70, such as "...and including a commercial unit for dealing with said commercials based at least partially on past viewing thereof" of Group III is not recited in the broadest combination claim 35 of Group I, claim 54 of Group II, claims 78 and 90 of Group IV, claims 84 and 88 of Group V, and claim 91 of Group VI.
3. The detail of the broadest sub-combination claims 78 and 90, such as "...deciding whether to record a program pursuant to a recording determination; and determining whether to play a program pursuant to a play determination based on a program rating" of Group IV is not recited in the broadest combination claim 35 of Group I, claim 54 of Group II, claim 70 of Group III, claims 84 and 88 of Group V, and claim 91 of Group VI.
4. The detail of the broadest sub-combination claim 84, such as "...broadcasting program material with a browsable program structure...a receiver browser for browsing said program material at least in accordance with said browsable program structure" and claim 88, such as "... with a program structure including non-user view controllable portion...a receiver-decoder browser for enabling user view control

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of said program material other than said non-user view controllable portion thereof” of Group V is not recited in the broadest combination claim 35 of Group I, claim 54 of Group II, claim 70 of Group III, claims 78 and 90 of Group IV, and claim 91 of Group VI.

5. The detail of the broadest sub-combination claim 91, such as “...a circular buffer...a conditional access module for providing conditional access to the program stored in the circular buffer; and...upon receiving a freeze indication via an input apparatus, ... to record the program in the circular buffer from a moment of receiving the freeze indication, and upon receiving a play indication via the input apparatus, ...to play the program recorded in the circular buffer from the moment of receiving the freeze indication in accordance with conditions determined by the conditional access module” of Group VI is not recited in the broadest combination claim 35 of Group I, claim 54 of Group II, claim 70 of Group III, claims 78 and 90 of Group IV, and claim 84 of Group V.

The subcombination has separate utility such as

- The subcombination Group II has separate utility apart from distributing encoded television program, commercial distribution within the broadcast television of Group I, from targeting commercials to users of group III, from recording and playback video program based on rating of group IV, from video-on-demand distribution of group V, and from video receiver with particular storage and control access function of group VI such as, recording video program with quality level.

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- The subcombination Group III has separate utility apart from distributing encoded television program, commercial distribution within the broadcast television of Group I, from recording video program with quality level of group II, from recording and playback video program based on rating of group IV, from video-on-demand distribution of group V, and from video receiver with particular storage and control access function of group VI such as, targeting commercials to users.
- The subcombination Group IV has separate utility from distributing encoded television program, commercial distribution within the broadcast television of Group I, from recording video program with quality level of group II, from targeting commercials to users of group III, from video-on-demand distribution of group V, and from video receiver with particular storage and control access function of group VI such as, recording and playback apparatus of video program based on rating.
- The subcombination Group V has separate utility from distributing encoded television program, commercial distribution within the broadcast television of Group I, from recording video program with quality level of group II, from targeting commercials to users of group III, from recording and playback video program based on rating of group IV, and from video receiver with particular storage and control access function of group VI such as, video-on-demand distribution.
- The subcombination Group VI has separate utility from distributing encoded television program, commercial distribution within the broadcast television of Group I, from recording video program with quality level of group II, from targeting commercials to users of group III, from recording and playback video program based

on rating of group IV, and from video-on-demand distribution of group V such as, video receiver with particular storage and control access function.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art, as shown by their different classification and their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hai Tran whose telephone number is 703-308-7372. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Faile can be reached on 703-305-4380. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

HT: ht  
06/25/2004

  
HAI TRAN  
PATENT EXAMINER